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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,346	06/07/2001	Tadashi Ichida	57139-5052	9056

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EXAMINER

SMITH, JULIE KNECHT

ART UNIT PAPER NUMBER

3682

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,346

Applicant(s)

ICHIDA ET AL.

Examiner

Julie K Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5, 7 and 10 is/are allowed.
- 6) ☒ Claim(s) 6, 8, 9 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Wendler (5,890,979). Wendler discloses a method of adjusting an initial position of a slave piston (4) in a hydraulic shift gear mechanism by providing a master cylinder assembly (2) in communication with a slave cylinder assembly (4), the master cylinder assembly attachable to a bicycle handlebar by a bracket and comprising a main chamber (14) having a master piston (10) and an adjuster chamber including an adjusting piston (15) threadingly engaged therein and a port for adding or removing air, said adjusting piston can be rotated to vary the depth in which the adjuster piston extends into the adjusting chamber.

Allowable Subject Matter

3. Claims 2-5, 7 and 10 are allowed.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendler as applied to claim 6 and 15 above, and further in view of Ose (5,676,022). Wendler discloses a hydraulic shift control device with a master cylinder and piston assembly, but does not disclose the operating movement of the shifter, as claimed. However, Ose teaches a shift lever assembly comprising a bracket (3) attachable to a handlebar, a pivot shaft (8) spaced apart from said handlebar and fixed to the bracket, a rotating member (4) rotatable in first (A) and second (B) directions about the pivot shaft, a control lever (4a) operatively connected to the rotating member wherein the lever is biased in a neutral position (N1) by springs (17, 20) and moveable in a first direction and second direction, said neutral position being located between said first and second positions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Wendler with the teachings of Ose to provide a shifter lever, as claimed, that moves in first and second directions, returning to a neutral position after operation. Wendler discloses a twist grip assembly for shifting, however, modifying the Wendler reference to have a lever assembly would have been obvious as the two types of shifting are old and well known in the art and merely a matter of preference by the rider.

Response to Arguments

6. Applicant's arguments, filed 8/4/04 with respect to claims 2-5, 7 and 10 have been fully considered and are persuasive.

7. Applicant's arguments filed 8/4/04 have been fully considered but they are not persuasive. Regarding applicant's arguments that the bleed screw of the Wendler reference is not a piston that can be adjusted to vary the depth of the screw (claims 6 and 15), it is clearly stated in the reference that the bleed screw is used for adding or removing air and can be rotated to vary the depth in which the screw extends into the chamber.

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (Claims 8 and 9), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Smith whose telephone number is 703-305-3948. The examiner can normally be reached on Monday-Friday, 8-5:30, (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJS
Jks

October 26, 2004

William C. Joyce 10/27/04
WILLIAM C. JOYCE
PRIMARY EXAMINER